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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/270,710	03/16/1999	LAWRENCE F. GLASER	740388-20	2842

7590  
Lawrence F. Glaser  
P.O. Box 92  
Fairfax Station, VA 22039

EXAMINER
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RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
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3622

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05/21/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/270,710	<b>Applicant(s)</b> GLASER, LAWRENCE F.	
	<b>Examiner</b> Yehdega Retta	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 27-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This office action is in response to amendment filed February 20, 2008. Applicant amended claims 27-49. Claims 27-49 are currently pending.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim recites a method of initiating a communication from a data processing system of an identified sending party. The claim however does not recite who or how the sending party is identified. Examiner's understanding is that the initiation of a communication is done by the user of the processing system, who is the sending party of the communication. Therefore it unclear how is the sending party considered "an identified party"? Also it unclear what is considered "identified sender's associated advertisement"?

Claim 48 is also rejected for the same reason stated above.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 27, 28, 30-35 and 37-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Markowitz (US 5,513,254).

Regarding claim 27, Markwitz teaches automatically transmitting an advertisement from a sending party to a receiving party comprising the steps of: initiating a communication from a data processing system of a sending party (the system identifies the user as pre-subscription of the user or the establishment of a connection) (see col. 2 lines 56-67, col. 4 lines 21-37); associating at least one pre-selected (identified) advertisement (see col. 5 lines 4-24) with said communication within the data processing system of the sending party (see col. 4 lines 36-57; and transmitting said communication with said at least one advertisement automatically embedded therein to the recipient (see col. 4 lines 58-67). Since there is no added step performed to indicated the advertisement is “an identified sender’s associated advertisement” and since the prior art teaches the association of an advertisement still reads on it.

Regarding claim 28, Markwitz teaches offering to a user an option of becoming an advertiser; and enabling, if the offer is accepted, a procedure within said data processing system by which the at least one advertisement is automatically associated with the sender's communications (see col. 2 lines 35-56, col. 4 lines 22-36).

Regarding claims 30, 37 Markowitz teaches the communication is at least one of e-mail, facsimile, etc. (see fig. 1).

Regarding claims 31 and 32, Markowitz teaches the advertisement is automatically sent for a pre-selected time period and a pre-selected number of times (see col. 6 lines 20-33).

Regarding claims 33, 40, Markwitz teaches the advertisement is electronically obtained from a third party data processing system (see col. 3 line 31 to col. 4 line 9).

Regarding claims 34, 38 Markwitz teaches compensating for accepting the offer to become an advertiser (see col. 2 lines 35-56, col. 5 lines 4-23).

Regarding claim 35, Markwitz teaches wherein the advertisement is at least one of visual and aural (see col. 4 lines 21-36).

Regarding claim 39, Markwitz teaches including fraud avoidance means for reducing or eliminating fraud (see col. 5 lines 4-23).

Regarding claim 41, Markwitz teaches wherein the advertisement is displayed automatically to recipient during a period of at least one of before, during and after the communication (see 4 line 58 to col. 5 line 3, col. 7 lines 1-21).

Regarding claim 42, Markwitz teaches the data processing system is at least one of a computer or telephone (see col. 2 lines 56-67).

Regarding claim 43, Markwitz teaches the advertisement automatically embedded in the communication by a third party (see col. 3 lines 49- 67, col. 4 lines 21-36).

Claims 27 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Kamel (US 5,937,037).

Regarding claim 27, Kamel teaches automatically transmitting an advertisement from a sending party to a receiving party comprising the steps of: initiating a communication from a data processing system of a sending party (see col. 1 line 55 to col. 2 line 10); associating at least one pre-selected advertisement with said communication within the data processing system of the sending party (see col. 2 lines 43-67, col. 4 lines 50-55); and transmitting said communication with said at least one advertisement automatically embedded therein to the recipient (see col. 10 lines 24-45).

Regarding claim 46, Kamel teach associating at least one pre-selected advertisement comprises automatically associating a personal testimonial by the sending party (see fig. 6A & 6B, fig. 12).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29, 44, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markwitz (US 5,513,254).

Regarding 29, Markowitz teaches that advertisement suppliers can provide advertisement (see col. 3 lines 38-63). However Markowitz does not explicitly disclose wherein the at least one advertisement (identified sender's associated advertisement) is related to at least one of software or hardware operable with the data processing system. It would have been obvious to one of ordinary skill in the art at the time of the invention to know that any advertisement, including advertisement about software or hardware could be included in Markowitz's system since the system does not exclude anyone from advertising.

Regarding claims 44 and 45, Markowitz teaches the advertisement is automatically determined at least in part by the recipient's profile (see col. 6 lines 20-33), but failed to explicitly teach that the profile includes demographic data such as gender, age, income, etc. Official notice is taken that is old and well known in the art at the time of the invention to know

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that customer profiles include demographic data such as age, income etc, for the intended purpose of providing targeted advertisement based on the demographic data.

Claims 36, 47, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markowitz (US 5,513,254) in view of Pirani et al. (US 5,105,184).

Regarding claim 36 and 47, Markowitz does not teach the advertisement is incorporated in setup software for one of software or hardware and is under the local control of the sending party, it is taught in Pirani (see col. 1 lines 35-64, col. 6 lines 45-67, col. 3 lines 1-22). It would have been obvious to one of ordinary skill in the art at the time of invention to modify Markowitz's system to incorporate advertisement within the software, in order to take advantage of the feature taught in Pirani.

Regarding claim 48, Markowitz teaches automatically transmitting an advertisement from a sending party to a receiving party comprising the steps of: initiating a communication from a data processing system of a sending party (the system identifies the user as pre-subscription of the user or the establishment of a connection) (see col. 2 lines 56-67, col. 4 lines 21-37); associating at least one pre-selected advertisement with said communication within the data processing system of the sending party (see col. 4 lines 36-57; and transmitting said communication with said at least one advertisement automatically embedded therein to the recipient (see col. 4 lines 58-67). Markowitz does not teach the pre-selected advertisement is under the local control of the sending party, it is taught in Pirani (see col. 1 lines 35-64, col. 6 lines 45-67, col. 3 lines 1-22). It would have been obvious to one of ordinary skill in the art at the time of invention to modify Markowitz's system to incorporate advertisement within the software, in order to take advantage of the feature taught in Pirani.

Regarding claim 49, Markowitz does not explicitly teach the advertisement includes a hyperlink. Official notice is taken that is old and well known in the art at the time of the invention to include a hyperlink in an advertisement. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a hyperlink in Markowitz's advertisement in order to provide a link to a website for more information or to purchase the advertised product or service of Markowitz.

### ***Response to Arguments***

Applicant's arguments filed February 20, 2008 have been fully considered but they are not persuasive.

Applicant argues that the present invention as amended, an identified user on a network seeking to communication to another user will find identified sender's associated advertisements automatically embedded into the communications according to preset preferences. Applicant states, user of a computer system sending a communication to a recipient will have an advertisement identified with the user automatically included in the communication. The claim however does not recite the user, who is initiating the communication, finds any advertisements automatically embedded in the communication. The independent claims recite ***associating*** advertisement with the sending part within the data processing system and ***transmitting*** the communication with advertisement automatically embedded therein to the recipient. The claim however does not recite the embedding of the advertisement is performed at user's processing system and then transmitted with the advertisement being embedded. In other words there is no indication of where the embedding is done.



Regarding the acquiring of hardware or software automatically causes advertisement to be embedded in any communication it is only in claim 36 that applicant indicates that the advertisement is incorporated in a setup of software and for this feature the Examiner relied upon Pirani. Regarding Pirani Applicant argues that Pirani modifies traditional software such that through the use of that software by any user, advertisements are inserted into the software. Applicant also argues that Pirani is limited to text and graphics only and does not suggested that the identity of the user changes the fact that advertisement will insert or will not be insert and Pirani does not suggest that for each identified user different advertisements will be inserted. Examiner would like to make it clear that the Pirani reference is used to show the feature of incorporating an advertisement in setup of software which is claimed in claim 36 and Markowitz is used for claim 28, for the teaching of offering the user of becoming an advertiser. Applicant also asserts that most operating systems currently in use require the user to log in and most communication networks require a user to log in order to become a sender of a communication but it is not clear to the Examiner if Applicant is implying that as claimed by Applicant there is no need to login to be identified. Applicant also argues that Markowitz does not disclose or suggest that the advertisement is displayed in operation of this Software as in Pirani. Examiner would like to point out that Applicant does not claim if the advertisement is displayed to the sending party or if the advertisement is incorporated or embedded before the user sends or transmitting the communication.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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YR  
/Yehdega Retta/  
Primary Examiner, Art Unit 3622